



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
[www.uspto.gov](http://www.uspto.gov)

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/075,486	02/13/2002	Byung Hee Hong	DE-1342	8775

7590

05/29/2003

David A. Einhorn, Esq.  
Anderson Kill & Olick, P.C.  
1251 Avenue of the Americas  
New York, NY 10020

EXAMINER

WONG, EDNA

ART UNIT PAPER NUMBER

1753

DATE MAILED: 05/29/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/075,486

Applicant(s)

HONG ET AL.

Examiner

Edna Wong

Art Unit

1753

-- Th MAILING DATE of this communication app ars on the cov r sh et with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_ .
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3,4,8 and 9 is/are rejected.
- 7) ☒ Claim(s) 2 and 5-7 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All   b) ☐ Some \*   c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_ .
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_ .
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_ .
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_ .

***Claim Objections***

Claim 2 is objected to because of the following informalities:

**Claim 2**

line 2, the word “promotor” should be amended to the word -- promoter --.

Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

Claims 3 and 8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

**Claim 3**

line 2, the words “needle-like” are indefinite.

**Claim 8**

line 1, “the reducing reaction” lacks antecedent basis.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

*Products*

I. Claim 4 is rejected under 35 U.S.C. 102(b) as being anticipated by **JP 11-246551**.

The JP reference teaches an organic nanotube (abstract; and Fig. 1).

As to the limitation of "synthesized by the method according to claim 1", the invention defined in a product by process claim is a product, not a process. *In re Bridgeford* 679, 149 USPQ 55 (CCPA 1966).

The patentability of a product by process claim does not depend on its method of production and where the examiner has found a similar product, the burden rests with the applicant to prove that that product is patentably distinct. See *In re Thorpe*, 227 USPQ 964 (CAFC 1985); *In re Marosi et al.*, 218 USPQ 289; *In re Pilkington*, 162 USPQ 145. "The lack of physical description in a product-by-process claim makes the determination of the patentability of the claim more difficult, since in spite of the fact that the claim may recite only process limitations, it is the patentability of the product claimed and not the process that must be established. We are therefore of the opinion that when the prior art discloses a product which reasonably appears to be identical with or only slightly different than a product claimed in a product-by-process claim, a rejection based alternatively on either section 102 or 103 of the statute is eminently fair and acceptable. As a practical matter, the Patent Office is not equipped to manufacture

products by the myriad processes put before it and then obtain prior art products and make physical comparisons therewith." *In re Brown*, 173 USPQ 685,688 (CCPA 1972).

II. Claim 9 is rejected under 35 U.S.C. 102(b) as being anticipated by **Moskovits et al.** (US Patent No. 5,581,091).

Moskovits teaches a nanowire (col. 1, line 61 to col. 2, line 13; and col. 2, line 63 to col. 3, line 13).

As to the limitation of "synthesized by the method according to claim 5", the invention defined in a product by process claim is a product, not a process. *In re Bridgeford* 679, 149 USPQ 55 (CCPA 1966).

The patentability of a product by process claim does not depend on its method of production and where the examiner has found a similar product, the burden rests with the applicant to prove that that product is patentably distinct. See *In re Thorpe*, 227 USPQ 964 (CAFC 1985); *In re Marosi et al.*, 218 USPQ 289; *In re Pilkington*, 162 USPQ 145. "The lack of physical description in a product-by-process claim makes the determination of the patentability of the claim more difficult, since in spite of the fact that the claim may recite only process limitations, it is the patentability of the product claimed and not the process that must be established. We are therefore of the opinion that when the prior art discloses a product which reasonably appears to be identical with or only slightly different than a product claimed in a product-by-process claim, a

rejection based alternatively on either section 102 or 103 of the statute is eminently fair and acceptable. As a practical matter, the Patent Office is not equipped to manufacture products by the myriad processes put before it and then obtain prior art products and make physical comparisons therewith." *In re Brown*, 173 USPQ 685,688 (CCPA 1972).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

#### ***Method***

Claims **1 and 3** are rejected under 35 U.S.C. 103(a) as being unpatentable over **JP 11-246551**.

The JP reference teaches a method of synthesizing a calix[4]hydroquinone (CHQ) organic nanotube comprising the steps of:

- (a) dissolving CHQ in a solution (= toluene); and
- (b) allowing the solution to evaporate off the resulting solution at a temperature to effectuate CHQ crystallization into a self-assembled nanotube (abstract; and Fig. 1)

The nanotube is in the form of a self-assembled tubular needle-like crystal (Fig. 1).

The JP reference does not teach wherein the solution is an aqueous acetone solution; and wherein the temperature ranges from 0 to 20°C.

However, the invention as a whole would have been obvious to one having ordinary skill in the art at the time the invention was made because one skilled in the art would have been motivated to have modified the method of the JP reference with wherein the solution is an aqueous acetone solution because different kinds of organic compounds dissolve in different kinds of solutions. The solution is a result-effective variable and one skilled in the art has the skill to determine the solution that would have successfully carried out the desired reaction, absent evidence to the contrary. MPEP § 2141.03 and § 2144.05(b).

An aqueous acetone solution is a conventional solvent in the art and well within the skill of the artisan to use dependent upon the kind of compound being dissolved, unless proven otherwise.

As to wherein the temperature ranges from 0 to 20°C, the temperature is a result-effective variable and one skilled in the art has the skill to calculate the temperature that would determine the success of the desired reaction to occur, absent evidence to the contrary. MPEP § 2141.03 and § 2144.05(b).

***Allowable Subject Matter***

The following is a statement of reasons for the indication of allowable subject matter:

Claim 2 defines over the prior art of record because the prior art does not teach or suggest the method of claim 1, wherein cesium sulfate ( $\text{Cs}_2\text{SO}_4$ ) is added to the aqueous acetone solution as a crystallization promoter.

Claims 5-8 define over the prior art of record because the prior art does not teach or suggest a method for synthesizing a nanowire, which comprises adding the organic nanotube of claim 4 to an aqueous solution containing a metal salt to let the metal ion enter the cavity of the nanotube and allowing the CHQ moieties of the nanotube to reduce the metal ion into the form of a nanowire.

The prior art does not contain any language that teaches or suggests the above. Therefore, a person skilled in the art would not have been motivated to adopt the above conditions, and a prima facie case of obviousness cannot be established.

Claims 2 and 5-7 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

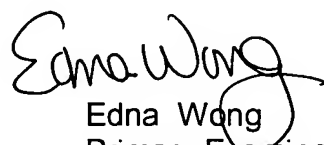
Claim 8 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.



Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edna Wong whose telephone number is (703) 308-3818. The examiner can normally be reached on Mon-Fri 7:30 am to 5:00 pm, alt. Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nam Nguyen can be reached on (703) 308-3322. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 873-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1495.

  
Edna Wong  
Primary Examiner  
Art Unit 1753

EW  
May 28, 2003